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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SCOTT J. JONES and KEVIN C. HUTTON

Appeal 2010-007647
Application 09/659,866
Technology Center 3600

Oral Hearing Held: September 8, 2011

Before JOSEPH A. FISCHETTI, BIBHU R. MOHANTY,
and MICHAEL W. KIM, *Administrative Patent Judges*.

APPEARANCES:

ON BEHALF OF THE APPELLANT:

MANUEL F. DE LA CERRA, ESQUIRE
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Carlsbad, California 92011

ALSO PRESENT: DR. KEVIN HUTTON

The above-entitled matter came on for hearing on Thursday,

35 September 8, 2011 commencing at 2:30 p.m., at the U.S. Patent and

1 Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Paula
2 Lowery, Notary Public.

3 P R O C E E D I N G S

4 THE USHER: Good afternoon. Calendar Number 15, Appeal
5 Number 2010-007647, Mr. de la Cerra.

6 JUDGE FISCHETTI: Good afternoon, Counsel.

7 MR. DE LA CERRA: Good afternoon.

8 JUDGE FISCHETTI: We've read the Briefs, and we're ready to go.

9 MR. DE LA CERRA: I'd like to thank you for your time. I'd also like
10 to reserve five minutes for rebuttal.

11 JUDGE MOHANTY: There's no Examiner here, so --

12 MR. DE LA CERRA: Is he not coming?

13 JUDGE MOHANTY: They very infrequently come.

14 MR. DE LA CERRA: Then I don't need five minutes because no one
15 is going to rebut me.

16 JUDGE FISCHETTI: Unless you want to reserve five minutes for
17 summary.

18 MR. DE LA CERRA: Let's reserve five minutes for summary. If it
19 would be at all possible to give me a seven minute warning or something
20 like that?

21 JUDGE FISCHETTI: Okay.

22 MR. DE LA CERRA: I'm the last of the day, I don't want to keep you
23 any longer than necessary.

24 JUDGE FISCHETTI: I'll let you know.

25 MR. DE LA CERRA: I have with me here Dr. Hutton, who is also an
26 inventor on the application, in case the panel had any questions for him.

1 One of the major issues in this case is a swear behind declaration
2 which Dr.

3 Hutton was one of the signatories to that.

4 JUDGE FISCHETTI: Okay.

5 MR. DE LA CERRA: I'd like to start with an introductory statement,
6 then I'll go ahead and go through the arguments I think are pertinent.

7 Then I'll go through those arguments in a little more detail, and
8 reserve the final five minutes for summary if need be.

9 Prior art is subject to the same enabling requirements that patent
10 applications are when they're examined. The prior art must enable in order
11 for it count as an anticipatory reference.

12 A list of features for undisclosed method is simply not enough, and
13 that's the problem with the AeroMed reference, which is one of the two main
14 references cited in the office actions that ultimately culminated in this
15 Appeal.

16 It doesn't enable anything because it's just simply a list of features,
17 and has absolutely no disclosure on how to implement those features. That's
18 not enough, and for that reason the AeroMed reference should be removed
19 as an anticipatory reference under 102(a).

20 Even if the AeroMed reference is deemed to be enabling, the
21 inventors here have shown they were in possession of the invention and
22 actually reduced it to practice prior to Aeromed. For that reason, 102(a)
23 prior to the invention thereof does not apply for AeroMed, and AeroMed
24 can't be 102(a) prior art. It's certainly not 102(b) prior art.

25 Finally, the Nathanson reference, which is the second reference that's
26 one of the two major references in the rejections, doesn't disclose all the

1 elements. It's Black letter law that the anticipatory reference has to disclose
2 all the elements within the four corners of the documents, either expressly or
3 inherently, to be an anticipatory reference under 102.

4 Here Nathanson does not disclose a module for comprising
5 instructions for tracking the actual flight path of the aircraft and determining
6 whether the actual flight path varies from the calculated flight path. This is
7 one of the elements of the rejected claims.

8 Because that's not there, and it's not in any of the other prior art that's
9 of record, the Examiner has not made out a *prima facie* case of obviousness.

10 Now, I'd like to go into --

11 JUDGE FISCHETTI: Let me say you were talking about Nathanson
12 in terms of anticipatory terms. You ended on obviousness.

13 MR. DE LA CERRA: It was a 103 rejection.

14 JUDGE FISCHETTI: Okay.

15 MR. DE LA CERRA: The element that was used in order to bring it
16 under 103 -- the missing element was simply that it was an aircraft.

17 JUDGE FISCHETTI: Okay.

18 MR. DE LA CERRA: That was the missing element in it. Otherwise,
19 Nathanson is used essentially -- it's a ground system that is used, essentially,
20 to cover all the three pertinent limitations here.

21 One of those limitations is missing, and under --

22 JUDGE FISCHETTI: The epitome is 102 is basically --

23 MR. DE LA CERRA: Yeah, it gets pretty close to a 102 reference.

24 JUDGE FISCHETTI: All right.

25 MR. DE LA CERRA: So the first argument is AeroMed is not
26 enabling. The enablement requirement applies to software patents, and the

1 federal circuit has held that a reference is not enabling which would require
2 one and a half to two years of man effort in order to achieve the undisclosed
3 disclosed. That's in Consolo Industries v. Vega Servo Control.

4 Here the entire portion of the AeroMed reference that is relevant to
5 the claims is about 14 lines long and amounts just to features with nothing
6 more. There are no flow charts, no source code, no diagrams, no algorithms,
7 nothing to show the implementation of the AeroMed technology.

8 Again, this just lists the features that are touted. But just listing
9 features is not enough, and has never been enough.

10 In fact, the federal circuit in Reading and Bates Construction v. Baker
11 Energy Resources held that a one page brochure that boasts the features of
12 an undisclosed process isn't sufficient as a matter of law to constitute an
13 enabling disclosure of that process. That's what AeroMed amounts to.

14 You also note that in our opening Brief we cited some parallel
15 proceedings that were going on in the office, one of which is the re-
16 examination of the parent application in this case.

17 Since this Appeal had been fully briefed and the Briefs had been
18 closed, the re-examination has actually concluded, and a re-examination
19 certificate has been issued.

20 As part of the notice of allowance in that re-examination certificate
21 for the parent, the re-examination -- let me back up a minute -- was based on
22 AeroMed technology. The same AeroMed technology we're referring to
23 here.

24 It's actually based on the flight management module, which if you'll
25 notice -- I'd like to present to the panel a bench book that basically has --
26 may I approach?

1 JUDGE FISCHETTI: Sure. This is the results of the re-examination?

2 MR. DE LA CERRA: No, I have those in a separate spot. These are
3 all the admitted evidence the Examiner has admitted.

4 In there you'll notice Tab A are the claims that are at issue. Tab B is
5 one of the non-patent references. Tab C is AeroMed. Tab D is Nathanson,
6 and Tab E is Yee, where Nathanson and Yee are patent references.

7 I put that there so it would be easy --

8 JUDGE FISCHETTI: Did these claims survive re-exam?

9 MR. DE LA CERRA: Yes, all the claims were confirmed at re-exam.

10 JUDGE FISCHETTI: All right.

11 MR. DE LA CERRA: The basis of that confirmation --

12 JUDGE FISCHETTI: Do you have that holding?

13 MR. DE LA CERRA: Yes, sir. Hold on a moment. Here's the re-
14 examination certificate. Here is the notice of intent to issue re-exam, the re-
15 examination certificate. That incorporates by reference the patent holder's
16 arguments.

17 JUDGE FISCHETTI: All right.

18 MR. DE LA CERRA: If you'll look at the patent holder's argument
19 beginning at page 15 or so, the inventor of the AeroMed reference was
20 deposed. That deposition transcript was submitted in that re-examination
21 proceeding.

22 In that deposition he admitted it took him 5,000 to 6,000 hours to
23 program the method described in the flight management module.

24 JUDGE FISCHETTI: He was deposed not as a result of the re-exam,
25 but --

26 MR. DE LA CERRA: Exactly, there had been two cases involving --

1 JUDGE FISCHETTI: Litigation?

2 MR. DE LA CERRA: Yes.

3 JUDGE FISCHETTI: Okay.

4 MR. DE LA CERRA: Involving the parent case. In the first case, the
5 inventor of the AeroMed reference was deposed.

6 JUDGE FISCHETTI: Okay.

7 MR. DE LA CERRA: It was the main reference. He admitted it was
8 5,000 to 6,000 hours of programming.

9 The important thing is that he was testifying as to the flight
10 management module and the dispatch module, which you'll notice in Exhibit
11 D, which is the AeroMed reference that was cited in the case pending now
12 on appeal.

13 On page 4 those are the two modules that are the basis of the elements
14 that are touted in the AeroMed reference that we're dealing with.

15 JUDGE FISCHETTI: Counsel, my problem right now is I don't have
16 that in the record before me.

17 MR. DE LA CERRA: You don't because it came in after --

18 JUDGE FISCHETTI: That affidavit falls short of that testimony, I
19 believe, of the 4,000 hours or the evidence of that 4,000 hours.

20 How many hours did you say?

21 MR. DE LA CERRA: He testified it was 5,000 to 6,000 hours.

22 JUDGE FISCHETTI: Is there evidence of that in the declarations that
23 are before us?

24 MR. DE LA CERRA: In this appeal there is not, Your Honor.

25 JUDGE FISCHETTI: I'm constrained on the record to what's before
26 us.

1 MR. DE LA CERRA: I understand that. I also do understand that the
2 re-examination certificate was not a Board decision.

3 I merely point that out to show that -- perhaps try to get to a
4 consistency of decision with the Office.

5 The Office did find, as you'll note in there -- did find that it was not
6 enabling. One of the reasons it found it was non-enabling was it was 5,000
7 to 6,000 hours.

8 JUDGE FISCHETTI: Okay.

9 MR. DE LA CERRA: That was the reason for raising it at this time. I
10 must stress the decision on this came out over a year after the file was closed
11 -- essentially, the briefing was closed in this case.

12 In countering the enablement argument, the Examiner cites In re:
13 Epstein for the proposition that the measure of the enabling disclosure
14 should be compared against the specification to figure out if enablement is
15 meant.

16 Here the specification and the Appeal Brief provide several flow
17 charts. I believe there's 31 figures of flow charts here to describe the
18 enablement of the specification as filed.

19 In particular, if you look at Figures 2 through 4 in the specification,
20 those flow charts show that this is, indeed, enabled.

21 JUDGE FISCHETTI: Counsel, assuming we have an enablement
22 here, we go on to the next issue of whether or not you can swear behind that.
23 Can you touch on those facts?

24 MR. DE LA CERRA: Sure, I'll move on.

25 We submitted a 131 declaration to swear behind this. In that
26 declaration Dr.

1 Hutton basically maps out the three elements that are based in Claim 2
2 to his exhibits.

3 The first element regarding the first module, if you look on Exhibit A,
4 Claim 2, the first indented claim limitation, the declaration at Paragraph 4(f)
5 specifically states, with support to Exhibits A(1), A(2), B(1), B(2), B(3) and
6 E(2) that there is support for that element.

7 The second element, same thing. At paragraph 4(g), supported by
8 exhibits contained in that declaration.

9 The same thing for the third element as well.

10 The Examiner's response to this appears to be limited to only looking
11 at the exhibits with no regard for the declaration. That's not appropriate.

12 In Ex Parte O'Hinsky, a declaration exhibit need not support all the
13 claim limitations. Any missing limitations can be supported by the
14 declaration. All the claim limitations are found in the exhibits in the
15 declaration language as specifically cited.

16 JUDGE FISCHETTI: Counsel, let me interrupt you here. The
17 drawings that are in these exhibits, particularly, for example, the Exhibits, are
18 they from the constructive reduction to practice on the patent application?
19 Or are they just part of what I'm reading is a business plan? That's what I'm
20 seeing.

21 MR. DE LA CERRA: That's a very good point, and I was going to
22 get to that.

23 You're exactly right. The exhibits which are under Tab B of the
24 handout which I gave you: Exhibits E(1), E(2) and E(3) are identical to the
25 exhibits that are ultimately in the specification, which was filed 25 days after
26 the AeroMed reference.

1 They are the same exhibits, and they are the basis for the support of
2 these claim limitations.

3 JUDGE FISCHETTI: Basically, you've got constructive reduction to
4 practice at least. We have the missing element of diligence.

5 MR. DE LA CERRA: I think there's more than simply constructive
6 reduction of practice. There's actual reduction of practice.

7 JUDGE FISCHETTI: My problem is the actual reduction of practice
8 is evidenced by a business plan, which suggests it's in the future. Golden
9 Hour Consultant's vision -- that leads your Exhibit A.

10 MR. DE LA CERRA: I understand your concern there. If you look at
11 the declaration at Paragraph 4(j), I'll just read from it: "After conception of
12 the invention is discussed above, the invention was either actually reduced to
13 practice or was undergoing due diligence to reduce to practice prior to
14 February 5, 1998."

15 Then it goes on to state there was a Beta test version implementing
16 what the declarant had just declared to that was publicly available and
17 disclosed at the AeroMed Transportation Conference in Cincinnati prior to
18 February 5, 1998, the relevant date we're talking about.

19 JUDGE FISCHETTI: What evidence do we have of that in this
20 declaration? Of that beta test?

21 MR. DE LA CERRA: His testimony that that was beta tested. That
22 should be sufficient.

23 If you look in In re: Tess –

24 JUDGE FISCHETTI: I'm not arguing that the beta test doesn't qualify
25 as actual deduction. The question is what evidence do I see before me that
26 supports that, outside of the statement of the declarant?

1 MR. DE LA CERRA: That is the evidence that's of record. A
2 statement of the declarant supported by his declaration showing all the
3 elements and modules of the system that was made.

4 It appears there's a bit of concern there.

5 JUDGE FISCHETTI: Sure. To add that evidence into the declaration
6 shouldn't be that hard to do.

7 MR. DE LA CERRA: Evidence of that was proposed to have been
8 added in a supplemental declaration, which the Examiner denied.

9 JUDGE FISCHETTI: That was never entered then.

10 MR. DE LA CERRA: It was never entered, but just for the sake of
11 being complete here, printouts of the source code and printouts of screen
12 shots were provided therein.

13 JUDGE FISCHETTI: From the beta test?

14 MR. DE LA CERRA: From the beta test, yes, Your Honor.

15 JUDGE FISCHETTI: That would have been a lot more helpful here.

16 MR. DE LA CERRA: I understand. We attempted to get it in, my
17 predecessor attempted to get it in, the Examiner would not accept it. We're
18 left with what we're left with.

19 JUDGE FISCHETTI: It was after you filed the Notice of Appeal?

20 MR. DE LA CERRA: Right, before the filing of the opening Brief
21 five or six years ago.

22 JUDGE FISCHETTI: Our hands are tied at this point.

23 MR. DE LA CERRA: I understand that, but let's not be too
24 pessimistic because I think there's diligence here.

1 Look, as he has declared, there was an actual reduction to practice of a
2 beta test. That beta test occurred before the AeroMed reference, which was
3 February 5, 1998.

4 The Examiner has admitted or conceded that the only period of due
5 diligence that we need to find is between that and the filing of the parent
6 application, which is 25 days later. We're talking about 25 days.

7 If you'll notice, and we just discussed, Exhibits E(1), E(2) and E(3)
8 were all drafts of a patent application. By that he had already submitted --

9 JUDGE FISCHETTI: Counsel, you asked me to remind you when
10 you were five minutes out. You're about that right now, you're inside of five
11 minutes.

12 MR. DE LA CERRA: I'll go ahead and wrap this element up, and I'll
13 try to wrap the Nathanson up, and leave it at that.

14 JUDGE FISCHETTI: Okay.

15 MR. DE LA CERRA: From the declaration what we know is he has
16 declared there was a beta test, and he has declared there were exhibits which
17 were the draft exhibits, which were ultimately the same exact drawings that
18 were committed in the application. That shows diligence because he's
19 already submitted his application to his patent attorney who's doing this.

20 I've been practicing patent law for 15 years. Patent applications take a
21 little bit of time to draft.

22 JUDGE FISCHETTI: Right.

23 MR. DE LA CERRA: Certainly three weeks to draft a patent
24 application --

1 JUDGE FISCHETTI: Counsel, maybe if we had an affidavit from
2 you or whoever was the drafting attorney on this to that effect, it would help
3 us close the gap of diligence there for that time period.

4 MR. DE LA CERRA: But it's inherent in the declaration.

5 JUDGE FISCHETTI: It's your testimony at that point. Once he turns
6 the application over to you, it's your diligence that we're looking at at that
7 point on.

8 MR. DE LA CERRA: I understand that. That's not in the record, and
9 I wasn't the attorney of record at that moment.

10 JUDGE FISCHETTI: Okay. So he can't make the affidavit for
11 somebody else.

12 MR. DE LA CERRA: I understand that. I want to stress that
13 ultimately the specification that was drafted was 32 pages long with about
14 30 flow charts. It was a very significant application that takes time to draft
15 and was, indeed, drafted over that time period of 25 days.

16 The final reference that was cited by the Examiner was Nathanson.
17 The key here is the Examiner has stressed that Nathanson, based on its
18 calculation of the fastest path, was a disclosure, or at least supported the
19 disclosure, that Element 3 of the patent claims at issue -- that instructions for
20 tracking actual flight of the aircraft, and instructions for determining whether
21 actual flight path varies from the calculated flight path, that that was support
22 for it.

23 However, the Nathanson patent only discloses the use of a minimum
24 path algorithm to calculate the minimum travel time. It does not disclose the
25 generation of an actual travel path.

1 Since there's no generation of an actual travel path that is disclosed,
2 no recordation of the actual travel path can occur. In contrast, the present
3 application discloses the storage of the flight information when connected
4 together via a stored list -- because there's no actual travel path to which
5 Nathanson could compare the calculated minimum path.

6 Applicants submit that the calculated minimum path of Nathanson,
7 which is the basis of the Examiner's rejection, cannot be used to determine
8 whether the actual path traveled by the ground vehicle varies from the
9 calculated minimum path as disclosed by the present invention.

10 Therefore, it's missing that critical limitation. There's nothing else in
11 the prior art that then supplies that limitation.

12 The Examiner nevertheless continues to argue that the recordation of
13 an estimated and actual pick-up and delivery time constitutes determining
14 whether an actual path varies from an assigned path; but recordation of
15 actual estimated times really doesn't give you anything.

16 They could, for example, take the actual path but it could take longer
17 or shorter. Or an alternate path could be taken, and it could take the same
18 time. Under Nathanson you wouldn't be able to account for this deviation.

19 Finally, the Nathanson reference the Examiner relies on the flight
20 path. That there is a disclosure for insertions to change a particular flight
21 path. But this stop insertion is for a very limited purpose.

22 This portion of Nathanson clearly does not disclose instructions for
23 determining the actual flight path the vehicle varies from the calculated path.
24 Rather, this instruction has been received from the dispatch program that
25 changes the intended destination of the vehicle as the intermediate

1 destination of the vehicle has been changed by this instruction, but has
2 nothing to do with the actual path of the ground vehicle.

3 This appears to be the only instance in Nathanson of a modification of
4 a route contemplated. That's the only instance of a modification of a route.

5 Therefore, I don't see how Nathanson could or would support the final
6 element that says instructions for determining whether the actual path
7 actually varies from the calculated flight path.

8 My final point, and it's very short, is the Examiner appears to focus on
9 the limitation of instructions to state that instructions could be -- he gave the
10 example of eggplant parmesan. It doesn't actually mean you're going to
11 make it.

12 But if you look at Claim 15, Claim 15 is not instructions for the
13 determination, it is the actual determination. I'll read the last two elements:
14 "The method for tracking the actual flight path of the aircraft and
15 determining whether the actual flight path varies from the calculated flight
16 path."

17 Nothing in Nathanson suggests that, teaches that, or otherwise
18 inherently discloses that. Nothing of the prior art that's of record discloses
19 that element. Without that element, you do not have all the elements to
20 prove obviousness under 103.

21 JUDGE MOHANTY: Can I ask you real quick -- indulge me.
22 Nathanson at Column 20, Line 23-26, it says: "This program updates the
23 vehicle's position in the network and on the screen."

24 MR. DE LA CERRA: What was the rest of that?

25 JUDGE MOHANTY: "The vehicle change program is activated
26 throughout the itinerary, and the position is updated on a screen."

1 Can you explain to me --

2 MR. DE LA CERRA: I'm sorry, I'm at Column 20 of Nathanson.

3 What's the line?

4 JUDGE MOHANTY: Line 23 through 26.

5 MR. DE LA CERRA: What is the question?

6 JUDGE MOHANTY: Just explain to me how that doesn't disclose the
7 claim limitation that you're arguing? He talks about the vehicle's position is
8 updated on the screen.

9 MR. DE LA CERRA: Yeah, but the update on the screen has nothing
10 to do between a comparison of the route that is calculated and the route that's
11 actually traveled.

12 Certainly with regard to Claim 15, the system needs to calculate that
13 deviation. There's nothing here that suggests that deviation is even
14 calculated.

15 In fact, there's no disclosure in Nathanson that shows an actual travel
16 path and the proposed travel path. There's nothing there. It doesn't make
17 that connection.

18 The reason I believe is that Nathanson is really based on the shortest
19 distance, which is based on times, not necessarily routes. Without having
20 the routes, how do you compare whether there's a deviation?

21 JUDGE MOHANTY: All right.

22 JUDGE FISCHETTI: Thank you.

23 MR. DE LA CERRA: Thank you again for your time.

24 (Whereupon, the proceedings at 2:55 p.m. were concluded.)